



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE NC 28280-4000

MAILED

JUL 18 2012

OFFICE OF PETITIONS

In re Patent No. 6,312,349
Issue Date: November 6, 2001
Application No. 09/430,756
Filed: October 29, 1999
Attorney Docket No: 059952/420058

ON PETITION

This is a decision on the PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE IN EXPIRED PATENT (37 C.F.R. § 1.378(b)), filed June 19, 2012.

The petition under 37 CFR 1.378(e) is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

The patent issued November 6, 2001. Accordingly, the second maintenance fee due could have been paid during the period from November 6, 2008 through May 6, 2009, or with a surcharge during the period from May 7, 2009 through November 6, 2009. This patent expired on November 6, 2009.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) payment of the appropriate maintenance fee, unless previously submitted; (2) payment of the surcharge set forth in 37 CFR 1.20(i)(1) and (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks item (3) above.

Petitioner, asserts that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

Specifically, Petitioner argues further that the delay was unavoidable in that he fully relied on his chosen representative, John B. Dickman III, to ensure that the patent remained in force, that the last contact he had with Mr. Dickman was in 2004 regarding the payment of the first maintenance fee and that in May 2012 he learned from Attorney Joe Gleason that his patent was expired and that Mr. Dickman died in April of 2005.

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").¹ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.² In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would

¹Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

²Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

³In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

have taken steps to ensure the timely payment of such maintenance fees.⁴ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.⁵

Petitioner's arguments have been considered but are not persuasive.

The evidence proffered suggests that the maintenance fee was not paid due to the lack of diligence on the part of either the petitioner or Mr. Dickman or both.

Based on the statement provided, Mr. Dickman was not diligent in ensuring that he had a back up notification system in his practice such that, as in his death, his clients would be notified and therefore in a position to secure alternative representation. Petitioner is reminded that in the absence of an adequate showing of the diligence of his representatives in this matter throughout the period in question, the actions or inactions of the registered practitioners will remain imputed to the inventors.⁶

Alternatively, as demonstrated by the practice of the Agent contacting the Patent Owner regarding outstanding issues, as in the last communication between the parties regarding the payment of the first maintenance fee in 2004, it does not appear that the petitioner was diligent regarding his patent for eight years especially in light of not having any communications with Mr. Dickman for that long.

In either case, it hasn't been established that failure to pay the second maintenance fee was unavoidable.

It is incumbent upon the petitioner to demonstrate, via a documented showing, that the entire delay was unavoidable which would include from the time the maintenance fee was due until the time petitioner became aware that the maintenance fee had not been paid, as well as from that point until the filing of the instant petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

⁴Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

⁵Id.

⁶See In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990).

By FAX: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in black ink, reading "Patricia Faison-Ball". The signature is written in a cursive, flowing style with a large initial "P".

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions